Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KANGHOON LEE

Appeal No. 2001-2106
Application No. 08/856,183[1]

HEARD: JANUARY 7, 2003

Before HAIRSTON, DIXON, and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1 and 2. Claims 3-20 are withdrawn from consideration as drawn to a non-elected invention.

We reverse.

BACKGROUND

Appellant's invention is directed to a computer program for controlling a printer using Java language to interpret page-layout requests. The printer receives Java print requests via a

[1] Application for patent filed May 14, 1997, which claims priority benefit under 35 U.S.C. from provisional Application 60/017,398, filed May 14, 1996.

server which converts the received print request from a Java request to a printer request for that specific printer (specification, page 7). Thus, according to Appellant, Java as an object oriented and architecture neutral language achieves improved distribution, language interpretation, security and compact image description in the claimed printer driver.

Representative independent claim 1 is reproduced below:

1. A computer program product, comprising:

a computer storage medium and a computer program code mechanism embedded in the computer storage medium for causing a printer to control rasterization of an image, the computer program code mechanism comprising:

a first computer code device configured to receive a print request as a series of method invocations using commands in a Java object oriented language syntax;

a second computer code device configured to rasterize the print request into an image; and

a third computer code device configured to output the image on a recording medium.

The Examiner relies on the following references in rejecting the claims:

Tom Bertram et al. (Bertram), "Print Rasterization Moves Hostward With Support From SCSI," Computer Technology Review, No. 6, Los Angeles, CA (US), 12 (1992) May, pp. 104-107.

"Java Language Specification (JLS)," Sun Microsystems, Inc., 1995.

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bertram in view of JLS.

Rather than reiterate the viewpoints of the Examiner and Appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 26, mailed February 13, 2001) for the Examiner's reasoning and to the appeal brief (Paper No. 25, filed December 6, 2000) and the reply brief (Paper No. 27, filed April 13, 2001) for Appellant's arguments thereagainst.

OPINION

At the outset, we note that Appellant states that claims 1 and 2 stand or fall together (brief, page 3). Accordingly, we will consider the claims as one group and will limit our consideration to independent claim 1 as the representative claim of the group.

The Examiner asserts that Bertram teaches the claimed computer storage medium and code mechanism for causing the operation of a print rasterization and outputting an image except for using commands in a JAVA object oriented language syntax (answer, pages 3 & 4). The Examiner, however, relies on JLS for disclosing the use of commands in JAVA object oriented language and concludes that JAVA syntax is compatible with other applications and may be used in Bertram's printer in order to

take advantage of the versatility and improved program execution of Java independent of the operating system (answer, pages 4 & 5).

Appellant argues that, contrary to the Examiner's interpretation of the reference, the compatibility described in JLS is a backward compatibility of each new version of Java with the existing Java applications (brief, page 5). Additionally, Appellant points to the listing of HTML, PDF and Postscript on page 1 of JLS and argues that such "languages" are formats in which the Java language specifications may be downloaded, not languages in other systems that are compatible with Java (brief, pages 4 & 5 and reply brief, pages 1 & 2). Appellant further questions the reason for the combination of Bertram and JLS and argues that the motivation to include Java language in such printers should be ruled out because Bertram provides a complete system at a time prior to development of Java language (brief, page 6).

In response to Appellant's arguments, the Examiner points to page 1 of JLS listing HTML, PDF and Postscript for download formats for concluding that a system using HTML, PDF and Postscript is compatible with Java since Java accepts such programs (answer, page 6). The Examiner further argues that

Bertram is indeed compatible with Java language since page 4 of JLS also indicates that Java may be implemented with existing applications such as PDF (answer, page 6). Finally, the Examiner relies on the first page of JLS to assert that indication of HTML, PDF and Postscript suggests that a system that uses such "languages" is allowed to use Java (answer, page 7).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The Examiner must not only identify the elements in the prior art, but also show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

A review of the applied prior art confirms that Bertram relates to the use of SCSI bus interface and driver to connect laser printers to computers and move the image rasterization from the printer side to the host computer (page 106, lefthand column). According to Bertram, using SCSI removes the need for a specific printer language and insures faster data transfer and screen images that are more consistent with the printed images (page 107, lefthand column). However, as contended by the Examiner, Bertram includes nothing related to the claimed print requests received as a series of method invocations using commands in a Java object oriented language syntax.

JLS, on the other hand, identifies Java as a general-purpose object-oriented programming language and discloses the specification of the syntax and semantics of Java language (page 4). More specifically, JLS describes the evolution of Java as completely compatible with existing applications wherein Java compilers and systems are capable of supporting the several different versions of Java simultaneously and with complete compatibility (id.). Furthermore, to provide various choices for downloading the language specification, JLS lists HTML, PDF and Postscript as the available download formats on page 1.

We disagree with the Examiner that the listing of HTML, PDF and Postscript download formats is an indication of compatibility of systems using such formats with Java. There is, in fact, nothing in JLS that directs us to conclude that the systems using such formats are compatible with Java, nor any disclosure related to Java being implemented with existing non-Java applications. In our view, the Examiner's conclusion that Bertram's printer may be used with Java format because HTML, PDF and Postscript download formats correspond both to the languages that are compatible with the printer of Bertram and existing Java systems, is unsupported by the prior art. As discussed above, Bertram does not recognize the benefits of using Java language in a printer driver and implements the conventional method of sending the rasterized and bit mapped images to a printer using the memory and processing resources of the host. On the other hand, JLS makes no reference to compatibility of Java language with systems that recognize HTML, PDF and Postscript formats.

In view of our analysis above, we find that the Examiner has failed to set forth a prima facie case of obviousness with respect to claim 1 because the necessary teachings and suggestions to arrive at the claimed printer driver that receives "a printer request as a series of method invocations using

commands in a Java object oriented language syntax" are not shown. Here, the Examiner's assertion that the combination of Bertram and JLS would have suggested the claimed subject matter could not stand as neither evidence in the prior art nor knowledge relied on by one of ordinary skill in the art supports such conclusion. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of independent claim 1, nor of claim 2 dependent thereon.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1 and 2 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)
JOSEPH L. DIXON Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
MAHSHID D. SAADAT Administrative Patent Judge	)

MDS/ki

Oblon, Spivak, McClelland, Maier
& Neustadt, PC
Fourth Floor
1755 Jefferson Davis Highway
Arlington, VA 22202